

Remarks

Claims 1 to 30 were pending and were before the Examiner. By this Amendment, applicants have canceled claims 9, 10, 19, 20, 29, and 30 without prejudice or disclaimer and amended claims 1 to 3, 7, 8, and 21 to 28. Applicants maintain that no new matter has been added by these amendments and therefore respectfully request that the Examiner enter the amendments presented. Amended claims 1 to 8, 11 to 18, and 21 to 28 are now pending and before the Examiner in this application.

The Examiner objected to claims 9, 10, 19, 20, 29, and 30 as being substantial duplicates of other claims.

In response, applicants have cancelled claims 9, 10, 19, 20, 29, and 30 and the objection is therefore moot. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the objection.

The Examiner rejected claims 21 to 30 under 35 U.S.C. § 112, first paragraph, as allegedly not enabling for bladder diseases.

In response, applicants have amended claims 21 to 28 to delete the recitation of bladder diseases (claims 29 and 30 having been cancelled) and the rejection is therefore moot. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

The Examiner rejected claims 1 to 30 under 35 U.S.C. § 103(a) as allegedly unpatentable over WO 96/32939 (alleged national stage equivalent: U.S. Patent No. 6,268,389) and DE 3712385.

In response, applicants traverse the rejection and maintain that the Examiner has not established a *prima facie* case of obviousness. A *prima facie* case of obviousness requires the satisfaction of three criteria: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings; (ii) there must be a reasonable expectation of success; and (iii) the references when combined must teach or suggest all of the claim limitations. See M.P.E.P. § 2143.

Applicants have conceded that certain phenyliminoimidazolidines are known in the art (see, e.g., Specification page 3, last two paragraphs). Applicants, however, have pointed out some advantages of the compounds of the claimed invention, for example:

... one of the aims of the present invention is to find new alpha 1L-agonists from the category of phenyliminoimidazolidines which act selectively on the bladder without substantially affecting the cardiac circulatory system and have favorable properties with regard to bioavailability or metabolism.

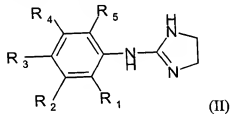
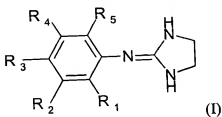
Surprisingly, it has been found that the *m*-alkylphenyliminoimidazolidines according to the invention achieve the aims of the present invention and are therefore suitable for treating urinary incontinence." (Specification page 3, paragraphs beginning on line 11 (emphasis added)).

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Version of the Claims with Markings to Show Changes Made by this Amendment
 in accordance with 37 C.F.R. § 1.121(c)(1)(ii), the following marked up version of the claims amended herein is provided to show all of the changes relative to the previous version of the claims before the amendments herein.

--1. (Amended) A compound of formula I or of tautomeric formula II



wherein:

R₁ and R₅ are each independently H, F, Cl, Br, CH₂F, CHF₂, CF₃, Me, or OMe;

R₂ and R₄ are each independently H, a branched C₃₋₆-alkyl, F, Cl, Br, CH₂F, CHF₂, CF₃, or Me, wherein at least one of the groups R₂ or R₄ is a branched C₃₋₆-alkyl; and

R₃ is H, F, Cl, Br, CH₂F, CHF₂, CF₃, or Me,

or a pharmacologically acceptable salt thereof.--

--2. (Amended) The compound according to claim 1, wherein:

R₁ and R₅ are each independently H, F, Cl, Br, CF₃, Me, or OMe;

R₂ and R₄ are each independently H, iPr, *tert*-Bu, F, Cl, Br, CF₃, or Me, wherein at least one of the groups R₂ or R₄ is iPr or *tert*-Bu; and

R₃ is H, F, Cl, Br, CF₃, or Me.--

--3. (Amended) The compound according to claim 1, wherein:

R₁ and R₅ are each independently H, F, Cl, Br, CF₃, Me, or OMe;

R₂ and R₄ are each independently H, iPr, *tert*-Bu, or Me, wherein at least one of the groups R₂ or R₄ is iPr or *tert*-Bu; and

R₃ is H, F, Cl, Br, or Me.--

--7. (Amended) A compound selected from the group consisting of:

(a) 3'-isopropyl-2'-methylphen-1'-yl-2-iminoimidazolidine-1;

(b) 3'-*tert*-butyl-6'-methoxyphen-1'-yl-2-iminoimidazolidine-2;

- (c) 6'-chloro-3'-isopropyl-2'-methylphen-1'-yl-2-iminoimidazolidine-~~3~~;
- (d) 4'-chloro-3'-isopropyl-2'-methylphen-1'-yl-2-iminoimidazolidine-~~4~~;
- (e) 6'-bromo-3'-isopropyl-2'-methylphen-1'-yl-2-iminoimidazolidine-~~5~~;
- (f) 6'-bromo-3'-*tert*-butylphen-1'-yl-2-iminoimidazolidine-~~6~~; and
- (g) 4'-bromo-3'-isopropyl-2'-methylphen-1'-yl-2-iminoimidazolidine-~~7~~--

--8. (Amended) 5'-chloro-3'-isopropyl-2'-methylphen-1'-yl-2-iminoimidazoline-~~27~~--

--21. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 1.--

--22. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 2.--

--23. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 3.--

--24. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 4.--

--25. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 5.--

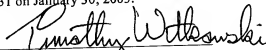
--26. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 6.--

--27. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 7.--

--28. (Amended) A method of treating urinary incontinence ~~or a bladder disease~~ in a patient in need thereof, the method comprising administering to the patient an effective amount of the compound according to claim 8.--

Certificate of Mailing Under 37 C.F.R. § 1.8(a)

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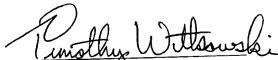


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Dated

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